

## REMARKS

### I. Introduction

Receipt of a non-final Office Action dated August 31, 2004, is acknowledged. In the Action, claims 1-5 and 8-14 were rejected as allegedly anticipated by Wiedmann *et al.*, U.S. Patent No. 5,747,001 ("Wiedmann"), and claims 1-14 were rejected as allegedly obvious over Wiedmann, in view of Czekai *et al.*, U.S. Patent No. 5,718,388 ("Czekai").

Applicants respectfully request reconsideration of the present application in view of the reasons that follow.

### II. Status of the Claims

In this response, applicants did not amend or add new claims. Accordingly, upon entry of this amendment, claims 1-14 will be under examination.

### III. Rejection of the Claims Under 35 U.S.C. § 102

Claims 1-5 and 8-14 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Wiedmann. Specifically, the claims were rejected because "Wiedemann [*sic*] teach nanoparticles of Bellomethazone [*sic*] having a surface modifier absorbed thereon . . . , tyloxapol is disclosed . . . , [and] particles less than 100nm are specified." Office action at 2. In addition, the action states that a "0.1-90% surface modifier is disclosed" and "[a]uxilliary surface modifiers are specified." *Id.* Applicants respectfully traverse this ground for rejection.

Wiedmann does not teach sterile filtered nanoparticulate active agent formulations, as required by the claimed invention. Specifically, the claimed invention recites a composition comprising nanoparticulate beclomethasone particles, nanoparticulate budesonide particles, or a combination thereof, having an effective particle size of less than about 150 nm, ***wherein the nanoparticulate composition is sterile filtered.*** See *e.g.* Claim 1. Since Wiedmann does not teach each and every element of the claimed invention, claims 1-14 are not anticipated by the cited art.

The composition of claimed invention is a species of the genus of compositions disclosed by Wiedmann, in which applicants' teach an additional processing step of the species not taught or suggested by Wiedmann. Specifically, Wiedmann teaches compositions comprising: (1) nanoparticulate beclomethasone particles, and (2) a surface modifier selected from an exhaustive list of exemplary surface modifiers (*see e.g.*, col. 3, line 30, through col. 5, line 65, of Wiedmann). Applicants surprisingly and unexpectedly discovered that nanoparticulate beclomethasone or budesonide particles, only having tyloxapol as a surface modifier, can be prepared at a very small particle size allowing for sterile filtering. This is not taught or suggested by the genus of compositions taught by Wiedmann.

#### IV. Rejection of the Claims Under 35 U.S.C. § 103

Claims 1-14 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Wiedmann in view of Czekai. In particular, the claims were rejected because Czekai "teach grinding of pharmaceutical substances (title)" and "sizes of 35 nm are specified," and therefore, "it would have been obvious . . . to use the method of Czekai at [*sic*] al to make the particles of Wiedemann [*sic*] et al to achieve the beneficial effect of smaller particles." Office action at 3. Applicants respectfully traverse this ground for rejection.

To establish a *prima facie* case of obviousness, there must be: (1) some suggestion or motivation to modify the reference or to combine reference teachings, (2) a reasonable expectation of success, and (3) when combined, a teaching or suggestion of all the claim limitations in the prior art references. *See* MPEP §2143 (Aug. 2001). "Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). As discussed above, Wiedmann does not teach or suggest sterile filtering the nanoparticulate active agent compositions of the invention, and the teachings in Czekai do not compensate for this deficiency.

The claimed invention is directed to the surprising discovery that compositions of nanoparticulate beclomethasone and/or nanoparticulate budesonide having tyloxapol as a surface stabilizer could be reduced to a particle size small enough to be sterile filtered. This

is surprising, as when beclomethasone and budesonide have one or more non-tyloxapol surface stabilizers, the compositions cannot be sterile filtered.

In addition, it is not only not possible to make sterile-filtered dispersions of beclomethasone or budesonide with stabilizers other than tyloxapol, it is not possible to make sterile filtered dispersions of other corticosteroids. Therefore, not only would it have not have been obvious to combine the teachings of Wiedmann and Czekai with a reasonable expectation of success, the combination would not teach each and every element of the claimed invention.

Therefore, for at least these reasons, the present invention is not obvious in view of Wiedmann and Czekai.

### CONCLUSION

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and arguments.

The present application is now in condition for allowance. Early notice to that effect is earnestly solicited.

The examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date November 30, 2004

By Michele M. Simkin

FOLEY & LARDNER LLP  
Customer Number: 22428  
Telephone: (202) 672-5538  
Facsimile: (202) 672-5399

Michele M. Simkin  
Attorney for Applicant  
Registration No. 34,717